APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,052	11/23/1999	SEISHI SUEHIRA	1075.1124/JD	3304

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EXAMINER
BIENEMAN, CHARLES A

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRC

	Application N. ⬤	Applicant(s)
Offic Action Summary	09/447,052	SUEHIRA, SEISHI
	Examiner	**Art Unit**	
	Charles A. Bieneman	2176	

-- *The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 November 1999_ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

4)☒ Claim(s) _1-48_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-48_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _23 November 1999_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _3_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to the following communications: original application, priority

document, and Information Disclosure Statement, all filed on November 23, 1999.

2.   Claims 1-48 are pending. Claims 1 and 48 are independent claims.

Priority

3.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers

have been placed of record in the file.

Specification

4.   The abstract of the disclosure is objected to because it exceeds 150 words. Correction is

required. See MPEP § 608.01(b).

Claim Objections

5.   **Claims 4-12** are objected to because of the following informalities: the phase "file

names same as" is not grammatical. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

7.   **Claims 1-48** are rejected under 35 U.S.C. 112, first paragraph, as containing subject

matter which was not described in the specification in such a way as to enable one skilled in the

art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention. Claim 1 recites converting non-structured documents into structured documents in

lines 19-21. The specification discloses at various points that a CPU carries out this conversion

(*e.g.,* page 19, lines 15-17; page 24, lines 25-27), but does not disclose the method or means by

which the conversion is actually done. Therefore, the disclosure would not have enabled one

skilled in the art to practiced the claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 1-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

Number 6,377,956 B1 to Hsu et al., issued April 23, 2002, filed February 22, 1999 in view

World Wide Web Consortium, *XML Schema Part I: Structures,* W3C Working Draft (May 6,

1999). With respect to the rejection of each dependent claim below, the preceding rejection(s) of

the relevant base claim(s) is incorporated therein.

Regarding **independent claim 1**, Hsu et al. teach setting in advance an original document

storage area for storing the non-structured documents inasmuch as they teach specifying database

tables or external files for the storage of component documents. (Hsu et al., col. 7, lines 26-32.)

Hsu et al. also teach setting in advance a structured document storage area for storing structured

documents obtained by conversion of the non-structured documents. (Hsu et al., col. 8 , lines 16-

18: "In the media preparation process, all source documents are processed and converted into

standard formats, in particular, SGML, and are stored in the document database.")

Further, Hsu et al. do not explicitly teach but it would have been obvious to one of

ordinary skill in the art to store the non-structured document into the original storage area each

time it was prepared or edited because it would have been obvious to one of ordinary skill that it

would be desirable to have the most updated version of the non-structured document available

for conversion to a structured document. (Hsu et al., col. 8, lines 16-18, quoted above.)

Further, Hsu et al. teach converting non-structured documents into structured documents

and storing them in the structured document storage area. (Hsu et al., col. 8, lines 16-18.)

Further, Hsu et al. do not teach acquiring document names of the structured documents

and preparing entity declarations for referring to entities of the structured documents. However,

XML Schema Part I teaches in section 3.6.2 on page 38 external parsed entities, "a feature of

XML that offers a method for including well-formed XML document fragments, including text

and markup, by direct reference to the storage object of the parsed entity." Further, in the

example at the top of page 39, *XML Schema Part I* depicts entity declarations containing the

names of structured documents. One of ordinary skill in the art would have recognized that these

entity declarations provide a straightforward and efficient way to refer to component documents,

and therefore, it would have been obvious to one of ordinary skill in the art to extend Hsu et al.

to acquire document names of the structured documents and prepare entity declarations for

referring to entities of the structured documents.

Further, Hsu et al. do not teach preparing the hub document based on the entity

declarations regarding the structured documents. However, *XML Schema Part I* in the example

in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the

structured documents. Moreover, one of ordinary skill in the art would have recognized that

basing a hub document on the entity declarations would have provided the benefit of flexible and

efficient document production, allowing reuse of components in different documents and

ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to have prepared the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claim 2**, Hsu et al. teach an attachment file storage area set in advance, and storing attachment files into the storage area, inasmuch as they teach the original file storage area as discussed above regarding claim 1 and further state that "[m]edia files, which are also document objects, are also managed in the same way as component documents." (Hsu et al., col. 7, lines 25-26.) Further, Hsu et al. do not teach preparing entity declarations for the attachment file or preparing the hub document based on the entity declarations for the attachment files as well as the entity declarations for the structured documents, but these elements would have been obvious to one of ordinary skill in the art in view of *XML Schema Part I* under the same rationale stated above regarding claim 1 for the obviousness of creating entity declarations and preparing the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claim 3**, the rejection of claim 2 above is fully incorporated herein. Further, Hsu et al. do not teach setting in advance an entity declaration storage area. However, in view of the obviousness of using entity declarations, discussed above regarding claim 1, it further would have been obvious to one of ordinary skill in the art to have set in advance an entity storage area because one of ordinary skill would have recognized the benefit of having a central storage area from which entity declarations could be accessed and used for multiple documents.

Regarding **dependent claims 4-6**, Hsu et al. do not teach the entity declarations of the structured documents having the same file names as the file names of the original unstructured document. However, one of ordinary skill in the art would have recognized that giving entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the entity declaration referred, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 7-12**, Hsu et al. do not teach the entity declarations for the attachment files having the same file names as the file names of the non-structured documents to which the attachment files are attached. However, one of ordinary skill in the art would have recognized that giving attachment entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the attachment was attached, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 13-24**, Hsu et al. teach the attachment files being graphic files including graphic information. (Hsu et al., col. 7, lines 61-65: "For each component document, the author also prepares for all needed multimedia files for diagrams, images, drawings, etc. in some standard formats such as CGM, TIFF, GIF, etc., which may be incorporated in the SGML files.")

Regarding **dependent claims 24-48**, Hsu et al. teach that the structured documents a Standard Generalized Markup Language (SGML) documents whose structure is defined by a Document Type Definition (DTD). (Hsu et al., col. 7, lines 33-37: "Component documents are preferably represented in SGML (See SGML: Standard Generalized Markup Language, ISO/IEC

8879:1986). SGML is a meta-language for defining document structures, referred to as

Document Type Definition (DTD). An SGML document structure is an instance of its associated

DTD.")

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

U.S. Patent Number	Name	Issue Date	File Date	
6,507,858 B1	Kanerva et al.	1/14/03	2/25/98	
6,490,603 B1	Keenan et al.	12/3/02	3/19/99	
6,202,072 B1	Kuwahara	3/13/01	12/5/97	
6,101,511	DeRose et al.	8/8/00	7/19/91	
6,014,680	Sato et al.	1/11/00	8/29/96	
5,655,130	Dodge et al.	8/5/97	10/14/94	

11.   World Wide Web Consortium, *Document Definition Markup Language (DDML)*

Specification, Version 1.0, W3C Note (January 19, 1999). See especially section 2.6.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045.

The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-746-7239 for regular

communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB
January 27, 2003

HEATHER H...
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